

Notice of Allowability

Application No.

09/890,927

Applicant(s)

SMITH ET AL.

Examiner

Rebecca L Anderson

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed 21 December 2004.
2. ☒ The allowed claim(s) is/are 5, 6, 20 and 27, now renumbered, 2-4 and 1 respectively.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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DETAILED ACTION

Claims 5, 6, 20 and 27 are currently pending in the instant application, are allowable over the prior art of record, and have been renumbered as claims 2-4 and 1, respectively.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

The application has been amended as follows:

Please insert the following sentence below the title on the first page of the specification:

--This application is a 371 of PCT/US00//04560 filed in English on 22 February 2000.--

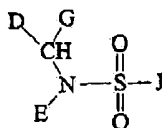
Response to Amendment

Applicants amendment filed 21 December 2004 has been entered and the cancellation of the method claims 21-26 and 28 has overcome the rejection of these claims under 35 USC 112 first paragraph. The amendment to claim 5 has overcome the 35 USC 112 second paragraph rejection of the claim. The amendment to claim 27 which inserts the specific substituents on the alkyl substituent of the phenyl J has overcome the 35 USC 102(b) rejection of claims 27, 5 and 20 since LINFIELD ET AL. requires the alkyl substituent on the phenyl J to be alkyl substituted alkyl, which is not a substituent found in amended claim 27.

Applicants arguments and the amendment to claim 27 have overcome the 35 USC 103(a) rejection of claims 27, 5, 6, and 20. Specifically, claim 27 has been amended to exclude the compound 105 as found in LINFIELD et al. by inserting the specific substituents found on the alkyl substituent of the phenyl J, which does not include alkyl as a possible substituent on the alkyl substituent of phenyl J. Furthermore, the only compounds in LINFIELD et al. which disclose other than a hydrogen in the position equivalent to applicants -CH(D)G substituent are the compounds 105 and 104 which have been shown in LINFIELD et al. as a comparison only to show that the replacement of the sulfonamide proton by an alkyl group destroyed activity. Therefore, LINFIELD et al. provides no motivation to modify the prior art compounds to applicants instantly claimed compounds which must have -CH(D)G instead of a hydrogen as found on all other compounds of LINFIELD et al except for compounds 104 and 105.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance. This invention relates to products of the formula:



The novel and nonobvious aspect of this invention involves the substituents J and CH(D)G. The closest prior art of record, LINFIELD et al., which discloses the compound 105 which is not within applicants instantly claimed invention, fails to teach or suggest the compounds as instantly claimed wherein the sulfonamide is substituted by other than a hydrogen and wherein the phenyl of J is substituted by other than an alkyl substituted alkyl.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

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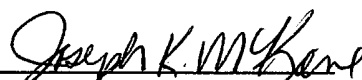
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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12/22/04



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